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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/071,692 | 02/08/2002 | Stefan Bonig | DT-6068 | 2080 |

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EXAMINER

LOPEZ, FRANK D

| ART UNIT | PAPER NUMBER |
|----------|--------------|
|----------|--------------|

3745

DATE MAILED: 03/08/2004

6

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/071,692

Applicant(s)

BONIG ET AL.

Examiner

F. Daniel Lopez

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 December 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3,5,8 and 9 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3,5,8 and 9 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 8 February 2002 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Response to Amendment

Applicant's arguments filed December 15, 2003, have been fully considered but they are not deemed to be persuasive.

Applicant has indicated that claims 4, 6 and 7 have been withdrawn. The office understands that this means they are canceled. If this is incorrect, please let the Office know what is meant by being "withdrawn".

Applicant argues that Termet discloses a stop forming ring 15 sitting in a recess, but does not disclose a braking element rolling in contact with an inclined base. This is true, but the ring 15 has a surface (25) which interacts with a surface (27) of the piston to hold the piston in its retracted position (column 4 line 4-9), thereby acting as a braking mechanism, which is released when the piston moves forward. Applicant continues, by arguing that Ehmig et al discloses braking balls in a recess, but the recess is in the wrong direction, such that the balls brake the piston as it moves forward, instead of releasing when it moves forward. Therefore, Ehmig et al does not disclose the claimed invention. Applicant concludes by stating that the combination of Termet and Ehmig et al do not meet the limitations of the claims, without going into detail of why this is so; even though the rejection made is a 103 rejection. Applicant's conclusion is wrong. Since the braking mechanism of Termet acts to release the piston as it moves forward, and since Ehmig et al teaches an equivalent braking mechanism; one of ordinary skill would understand how to replace the braking mechanism of Termet with the braking mechanism of Ehmig et al, including positioning the incline so as to release the piston as it moves forward.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Drawings

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the braking element being a roller, or a circular cylinder (claim 3), must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

Claim 9 is and are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 9 line 2 "said braking means" should be –said means for biasing—, to agree with claim 1 line 18.

Claim Rejections - 35 USC § 103

Claims 1-3, 5, 8 and 9 and are rejected under 35 U.S.C. § 103 as being unpatentable over Termet in view of Ehmig et al. Termet discloses a setting tool comprising a piston (11) in an axially extending piston guide (5) and having a cylindrical section (13) close to a leading end, and a conical shaped surface (26) extending from the cylindrical surface, toward a trailing end; the conical surface being inclined inwardly towards the trailing end; a plate type (two semi-annular elements) braking element (15) mounted in a recess (20) of the guide in pressure contact with the cylindrical section, when the piston is in a ready to fire position, and the pressure contact reduces as the piston moves toward a leading end of the guide and the braking element is adjacent the conical surface; but does not disclose that there is a means in the recess biasing the braking element toward the piston, with the biasing means being an axially expending compression spring; wherein the recess has a base spaced radially outwardly from the piston and extending generally in an axial direction, and having an incline outward toward the trailing end of the guide, with the biasing means biasing the braking element toward the leading end of the piston toward a wall of the recess perpendicular to the axis; or that the recess is either elastic or resilient.

Ehmig et al teaches, for a setting tool comprising a piston (11) in an axially extending piston guide (5) and having a braking element (including 17) mounted in a recess (16, and formed by 18) of the guide in pressure contact with a cylindrical section of the piston; that there is a means in the recess biasing the braking element toward the piston, with the biasing means being an axially expending compression spring (22); wherein the recess has a base spaced radially outwardly from the piston and extending generally in an axial direction, and having an incline (formed by 18a) outward toward the trailing end of the guide, with the biasing means biasing the braking element toward the leading end of the piston toward a wall (16) of the recess perpendicular to the axis; and that the recess is elastic and resilient (18, e.g. column 3 line 46).

Since the braking element of Termet and Ehmig et al are functionally equivalent in the piston art; it would have been obvious at the time the invention was made to one having ordinary skill in the art to replace the braking element of Termet with a braking element including a means in the recess biasing the braking element toward the piston, with the biasing means being an axially expending compression spring; wherein the recess has a base spaced radially outwardly from the piston and extending generally in an axial direction, and having an incline outward toward the trailing end of the guide, with the biasing means biasing the braking element toward the leading end of the piston toward a wall of the recess perpendicular to the axis; and that the recess is elastic and resilient, as taught by Ehmig et al, as a matter of engineering expediency.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

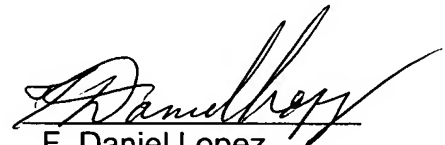
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

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extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dan Lopez whose telephone number is (703) 308-0008. The examiner can normally be reached on Monday-Thursday from 6:30 AM -4:00 PM. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ed Look, can be reached on (703) 308-1044. The fax number for this group is (703) 872-9306. Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0861.



F. Daniel Lopez
Primary Examiner
Art Unit 3745
March 05, 2004